

REMARKS

Claims 14-18 and 21-32 and 34-39 are pending in the above-identified application. Claims 14-20, 23, 25, 30-35 and 37 have been cancelled herein. Claims 24 and 26 have been amended to independent form and recite all elements of their respective base claim. Claims 27-29 have been amended to depend from independent claims 21, 24 and 26 and claim 38 has been amended to depend from claim 36. Following entry of the amendments claims 21, 22, 24, 26-29, 36, 38 and 39 will be pending and under examination. Support for each of the amendments can be found in the claims as filed. For example, claim 24 and 26 have been amended to recite claims 23 and 25, respectively. All other amendments merely change dependency to a non-cancelled claim. Accordingly, the amendments do not raise any issue of new matter and entry thereof is respectfully requested.

Rejections Under 35 U.S.C. § 102

Claims 14-18, 23, 25, 30-32 and 34 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated over Drmanac et al., EP 0392546. The Office alleges that Drmanac et al. describes all elements of the claimed invention.

Applicants respectfully submit that Drmanac et al. fails to describe the invention as set forth in the rejected claims. Nevertheless, Applicants have cancelled the rejected claims without prejudice. Applicants reserve the right to prosecute these claims in a later filed application claiming the benefit of priority to the priority application for this application. Accordingly, this ground of rejection is moot and its withdrawal is respectfully requested.

Rejections Under 35 U.S.C. § 103

Claims 35 and 37-39 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over Drmanac et al. in view of Dower et al. The Office alleges that Drmanac et al. describes nucleic acid targets linked to microspheres, but concedes that the linkage lacks a receptor-ligand interaction. Dower et al. is cited for allegedly describing a receptor-ligand interaction. The Office concludes that it would have been obvious to one of ordinary skill in the art to arrive at the claimed invention in light of Drmanac et al. and Dower et al.

Applicants respectfully submit that Drmanac et al. in view of Dower et al. fails to render the invention obvious as set forth in the rejected claims. Nevertheless, Applicants have cancelled the rejected claims without prejudice. Applicants reserve the right to prosecute these claims in a later filed application claiming the benefit of priority to the priority application for this application. Accordingly, this ground of rejection is moot and withdrawal is respectfully requested.

Obvious-Type Double Patenting Rejection

Claims 14-18, 23, 25, 30-32 and 34-39 stand rejected under the judicially created doctrine of obvious-type double patenting over claims 1-36 of U.S. Patent No. 6,913,884 in view of Drmanac et al. Although the claims are not identical, the Office alleges that the '884 patent describes a solid support as a microsphere and that Drmanac et al. describes immobilization onto microspheres. The Office concludes that it would have been obvious to one of ordinary skill in the art to apply the microspheres of Drmanac et al. to the '884 patent's solid support to arrive at the claimed invention.

In light of Applicants amendments and remarks above, the only outstanding issue with respect to currently pending claims 21, 22, 24, 26-29, 36, 38 and 39 is the obvious-type double patenting rejection.

Applicant submit that currently pending claims 21, 22, 24, 26-29, 36, 38 and 39 are unobvious over claims 1-36 of the '884 patent at least because the claims in the subject application are a species of the solid supports in the '884 patent. Nevertheless, Applicants submit herewith a terminal disclaimer over claims 1-36 of U.S. Patent No. 6,913,884 and a certificate under 37 CFR 3.73(b) establishing the assignee's rights in the invention. In view of the terminal disclaimer, Applicants respectfully request that the Examiner withdraw this rejection and allow the case to proceed to issuance.

CONCLUSION

In light of the Amendments and Remarks herein, Applicants submit that the claims are in condition for allowance and respectfully request a notice to this effect. In particular, claims 21, 22, 24, 26-29, 36, 38 and 39 stand rejected only over an alleged obvious-type double patenting.


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Applicants timely filing of a terminal disclaimer obviates this ground of rejection. Should the Examiner have any questions, she is invited to call the undersigned attorney.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read "D. A. Gay", written over a horizontal line.

David A. Gay
Registration No. 39,200

4370 La Jolla Village Drive, Suite 700
San Diego, CA 92122
Phone: 858.535.9001 DAG:MWE
Facsimile: 858.597.1585
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